

REMARKS

SUMMARY

Reconsideration of the application is respectfully requested. Applicants have submitted a Request for Continued Examination under 37 CFR 1.114 of the instant application with this response.

Claims 1-34 are now in the application. Claims 29-34 have been added. Claims 1, 2, 5, 7-10, 15-17, 19-26 and 28 have been amended. All amendments and new claims are fully supported by the original disclosure as indicated below. No new matter has been introduced.

PROSECUTION ACKNOWLEDGMENTS

In “Response to Amendment” the first paragraph on page 2 of the above-identified final Office Action, the Examiner stated that applicants’ arguments with respect to claims 1-28 had been considered, but are now moot in view of the new grounds of rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In “Claim Rejections – 35 USC § 103” the third paragraph on page 2 of the above-identified final Office Action, claims 1-4, 7, 9, 10, 12-18, 21, 23-24, and 26-28 have been rejected as being obvious over U.S. Patent Application Publication No. 2003/0194990 to *Helperich* (hereinafter “**HELPERICH**”) in view of U.S. Patent No. 5,948,061 to *Merriman, et al.* (hereinafter “**MERRIMAN**”) under 35 U.S.C. § 103(a). Applicants respectfully traverse.

As will be explained below, applicants believe that the pending claims are patentable over the cited art. Support for the changes is found on pages 5-7 and pages 16-26 of the specification and in the originally filed claims of the instant application. No new matter has been added.

Similarly, support for the new claims 29-34 is provided on pages 16-19 of the specification of the instant application. More specifically, support for new claim 29 is found on page 16 line 9, claim 30 on page 16 lines 14-15, claim 31 on page 16 lines 19-20, claim 32 on page 17 lines 10-11, claim 33 on page 18 lines 5-10, and claim 34 on page 19 lines 5-10. As such, no new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 as amended calls for, *inter alia*, a method for a server to provide a response to a request for service from a wireless device, including:

- receiving by the server the request for service from the wireless device;
- determining by the server one or more associated service providers** based at least in part on the service requested;
- retrieving by the server from one or more other servers **of the one or more service providers** primary response data for responding to the request;
- determining by the server** whether secondary data unrelated to responding to the request are to be provided to the wireless device;
- associating by the server** the retrieved primary response data, **retrieved from the one or more servers of the one or more service providers**, with either one or more indications of locations of the secondary data or at least a portion of the secondary data;
- generating by the server an expanded response to the request, **including the primary response data and** the portion or the indication(s) of the location(s) of **the secondary data**; and
- transmitting by the server the expanded response to the request to the wireless device.

Independent claims 9, 15, and 23 contain similar language.

Thus, the instant application calls for determining one or more associated service providers based at least in part on the service requested, retrieving primary response data from at least one of the service providers, determining whether secondary data that is unrelated to responding to the original request are to be provided to the wireless device by a system server. The secondary data may enable the server to provide robust and dynamic responses to requests from users of the wireless devices. In this manner, a wireless device may receive desired information not specifically related to the instigating request. For example, a wireless device might primarily request reservation data and in response the

server may transmit secondary data including either a notification of new mail or the electronic mail along with the primary reservation data. Similarly, a query for new mail as the primary data could result in the transmission of reservation data as secondary data.

Turning now to **HELFERICH**, the applicants initially note that in view of previously filed declarations during prosecution of the instant application, the Examiner should only consider the disclosure materials of **HELFERICH** that are found in provisional application 60/126,939 filed March 29, 1999 and/or shared in common with the parent continuation-in-part applications now issued as US patents 6,233,430, 6,253,061, 6,087,956, 6,259,892, and 6,097,941. Likewise, new material introduced by provisional application 60/155,055 filed Sept. 21, 1999 and the parent continuation patent application 09/540,490 filed March 31, 2000 should be excluded from consideration. As such, applicants respectfully request that the Examiner consider replacing **HELFERICH** with an alternative reference or one of the previously listed parent patents, so as to eliminate the existing ambiguity of which portions of **HELFERICH** may be used as prior art. In the alternative, applicants request that the Examiner include the previously listed parent continuation-in-part patents on PTO-892.

This position is supported by MPEP § 201.11, which indicates that any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application; *In re Chu*, 66F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Von Lagenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and *Chromalloy American Corp. v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972).

Moreover, applicants respectfully assert that the **HELFERICH** reference is non-analogous with **MERRIMAN** and as such the proposed combination is impermissible. “Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination”. In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). “Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). “Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘**clear and particular.**’” Winner Int’l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). There is no “clear and particular” teaching or suggestion in **HELFERICH** to incorporate the features of **MERRIMAN**, and there is no teaching or suggestion in **MERRIMAN** to incorporate the features of **HELFERICH**. In support of this position, applicants note that **MERRIMAN** contains no reference to either “wireless” or “wireless devices” as recited in the instant application, nor is there any motivation in **HELFERICH** to make the proposed combination.

The **HELFERICH** reference discloses a wireless messaging system. The disclosed system includes a mobile phone 10, antenna 12, mobile system 14, email server 16, and message processor 18. The message processor 18 and email server 16 are connected to the Internet 20. However, as indicate in the above-identified final Office Action, **HELFERICH** does not disclose determining whether secondary data unrelated to responding to the request exists. Moreover, as there is no identification of the secondary data there is also no determination of whether the secondary data should be provided to the wireless device as recited in claims 1, 9, 15, and 23 of the instant application. Furthermore, **HELFERICH** fails to teach or suggest the use of a plurality of service providers to supply the primary response data.

In contrast, the server in the present invention determines **one or more associated service providers** based at least in part on the service requested from the wireless device and **retrieves primary response data** from one or more other servers of **the one or more service providers**. In addition, the server in the instant application determines whether **secondary data unrelated to the request are to be provided** to the wireless device.

Clearly, **HELPERICH** does not show “determining by the server one or more associated service providers based at least in part on the service requested” as recited in claim 1 of the instant application. Nor does **HELPERICH** teach or suggest “determining by the server whether secondary data unrelated to responding to the request are to be provided to the wireless device” as recited in claim 1 of the instant application.

The **MERRIMAN** reference discloses the delivery, targeting, and measuring of advertisements over networks, such as the Internet. Applicants respectfully note that **MERRIMAN** provides no mention of “wireless” or “wireless devices” as part of the network. Moreover, **MERRIMAN** specifically identifies the user and delivers **targeted advertising** to the individual users. As such, applicants respectfully traverse the position of the above-identified final Office Action that **MERRIMAN** provides “secondary data **unrelated** to responding to the request” as the underlying principle in **MERRIMAN** is that the advertisements are targeted and as such are very related to the request and the user profile of the user making the request.

In contrast, the server in the present invention determines **one or more associated service providers** based at least in part on the service requested **from the wireless device** and retrieves primary response data from one or more other servers of the one or more service providers. In addition, the server in the instant application determines whether **secondary data unrelated to the request are to be provided to the wireless device**. As previously indicated, the secondary data may enable the server to provide robust and dynamic responses to requests from users of the wireless devices. In this manner, a wireless

device may receive **desired information** not specifically related to the instigating request, such as sending “mail” related secondary data along with requested primary “reservation” data. Similarly, the query for new mail as the primary data could result in the transmission of reservation data as secondary data.

Clearly, **MERRIMAN** does not show a “**wireless device**” and as a result **MERRIMAN** cannot show “determining by the server whether secondary data unrelated to responding to the request are to be provided **to the wireless device**” as recited in claim 1 of the instant application. Nor does **MERRIMAN** teach or suggest “determining by the server one or more associated service providers based at least in part on the service requested” as recited in claim 1 of the instant application.

Moreover, the proposed combination of **HELFERICH** and **MERRIMAN** do not teach or suggest “determining by the server one or more associated service providers based at least in part on the service requested” as recited in claim 1 of the instant application. Nor does the proposed combination of **HELFERICH** and **MERRIMAN** teach or suggest “determining by the server whether secondary data unrelated to responding to the request are to be provided to the wireless device” as recited in claim 1 of the instant application.

Similar distinctive language may be found in independent claims 9, 15, and 23.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 9, 15, or 23. Claims 1, 9, 15, and 23 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they are ultimately dependent on claims 1, 9, 15, or 23.

In the event the Examiner should still find any of the remaining claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible,

patentable language can be worked out. In the alternative, the entry of the amendment is requested.

Petition for extension is herewith made. The extension fee for response within a period of three months pursuant to Section 1.136(a) in the amount of \$1020.00 in accordance with Section 1.17 is enclosed herewith.

CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 1-34 are solicited. As a result of the amendments made herein, applicants submit that claims 1-34 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1509. If any additional fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

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